

REMARKS

This paper is responsive to the Office Action dated March 25, 2004 (hereinafter the "Office Action"). In the Office Action, Claims 1-3, 8, and 11 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. D367,998 issued to Graw et al.; Claims 1-7, 11-13, 17, and 19 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,066,886 issued to Henn; and Claims 11 and 16 were rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,995,333 issued to Pazzano. The Office Action further objected to applicants' drawings for an alleged failure to comply with 37 CFR 1.84(p)(5), namely for including a reference sign in the drawings but not in the description. The Office Action additionally objected to the form of the claims, with a query to the applicants whether the claimed subject matter is intended to cover a combination or subcombination.

Drawings

The Office Action notes reference sign "34" as being shown in the drawings but not in the description. Applicants respectfully call attention to page 7, line 8 of the description where reference sign "34" is incorporated into the description. Applicants believe the objection was raised in error and respectfully request that the objection be withdrawn.

Claim Objections

The Office Action requests clarification of whether the claims are drawn to a combination of a hanger and a cap, or a subcombination of a hanger. The claims in the present application are intended to cover the subcombination of a hanger. A cap is identified in the preamble solely to provide context for the sizing of the "coil" and configuration of the "body" and "hook", which are recited in Claim 1, and for the claiming of "retaining structure" and "securing structure" that comprise the apparatus recited in Claim 11. The cap is also representative of the environment in which the claimed invention functions. A cap is identified

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

in the claims only to provide an effective reference for the structural elements comprising the hanger/apparatus being claimed.

Claims 1 and 11 have been amended to further emphasize the foregoing points. Nevertheless, the amendments do not narrow the claims, nor are they required for purposes of patentability. The claims should be examined for both their literal and equivalent elements. Should the Examiner have any further concerns or objections to the form of the claims, the Examiner is invited to contact applicants' attorney by telephone.

Claim Rejections

Prior to discussing in detail why applicants believe the claims in this application are allowable, a brief description of applicants' disclosure and a brief description of the teachings of the cited references are provided.

Brief Description of Applicants' Disclosure

Applicants' disclosure solves the problem of what to do with a cap when the cap is removed from a container, such as a fuel tank cap that is removed from a fuel tank. Applicants provide an apparatus that fits *inside* the cap and can be used to secure the cap to an external structure, such as a brake cable of a motorcycle.

More specifically, the apparatus includes retaining structure configured to fit inside a cap. The retaining structure may use friction developed under spring tension, for example, to engage an inner surface of the cap, or may use a fastener such as a screw, or both, inside the cap. The retaining structure is connected to a securing structure, such as a hook, clip, or loop with a closure mechanism, for example. The securing structure releasably secures the apparatus to an external structure.

In one embodiment, the apparatus is a hanger comprised of a coil, a body connected to the coil, and a hook connected to the body. The coil is sized to fit *within* a cap, such as a fuel

tank cap, for example. The coil can be constructed and installed inside a cap such that spring tension of the coil presses the coil outwardly against the *interior* of the cap, allowing the coil to be retained in the cap. The hook can then engage an external structure (such as a brake cable when used with a motorcycle), allowing the cap to hang from the external structure. Other embodiments and applications for the invention can be envisioned from the foregoing.

U.S. Patent No. D367,998 to Graw et al.

The '998 patent to Graw et al. (hereinafter "Graw") is a design patent for a self-leveling beverage holder. Self-leveling of the beverage holder is accomplished by providing a pivot point where the beverage holder is interfaced with an external structure through a "buckle", as shown in the drawings. Unlike the apparatus disclosed and claimed in the present application, the Graw apparatus is essentially a cage made of coils that surround and hold a beverage container (such as a cup, glass or bottle) when the container is placed into the coils of the beverage holder. The coils are located on the *outside* of the container. This sharply contrasts with the apparatus in the present application where the retaining structure (e.g., coils) are placed *inside* a container cap to secure the apparatus to the cap.

U.S. Patent No. 2,066,886 to Henn

Henn teaches an apparatus made of coils that attaches to the handle of an implement, such as a mop, broom, or the like. The coils of the apparatus surround and attach to the *outside* surface of the implement handle. This is diametrically opposite of the teaching of the present application in which a retaining structure fits *inside* the cap of a container and bears against an *inner* surface of the cap.

U.S. Patent No. 2,995,333 to Pazzano

Similar to the Graw apparatus, Pazzano discloses a coiled apparatus designed "to receive and hold a liquid receptacle such as a drinking glass 'G'." (See column 2, lines 37-38). The

Pazzano apparatus includes a mount that engages the outer surface of a chair leg; likewise the coiled cylindrical receiver engages the outside of the drinking glass "G". Pazzano uses a cage retention method similar to that taught in Graw to hold the drinking glass. Notably, Pazzano does not teach a retaining structure configured to fit *inside* a cap, as claimed in the present application.

The Claims Distinguished

In order to anticipate a claim under 35 U.S.C. § 102(b), a reference must teach each and every element of that claim.¹ Thus, if every element of a claim is not described or suggested by the reference, the claim cannot be rejected under 35 U.S.C. § 102(b).

The hanger claimed in independent Claim 1 requires "a coil sized to fit *within* a cap of a container." (Emphasis added). Moreover, the claimed "body" and "hook" both function as described "when the coil is installed *inside* the cap." (Emphasis added). These elements are nowhere described or suggested in the Graw, Henn, or Pazzano references. Quite opposite, these references expressly teach away from Claim 1 by describing structure that engages the *outside of a container*. Alone, this distinction is sufficient to overcome rejection under 35 U.S.C. § 102(b). Additional differences distinguish the teachings of Graw, Henn, and Pazzano from the claims in the present application.

Independent Claim 11 is also patentably distinguished over the teachings of Graw, Henn, and Pazzano. For example, Claim 11 requires "retaining structure configured to fit *inside* a cap and engage the *interior* of the cap when the retaining structure is installed inside the cap." (Emphasis added). Moreover, the claimed securing structure releasably secures a cap to an external structure "when the retaining structure is installed *inside* the cap and the cap is removed

¹ *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987).

from the container." (Emphasis added). The "retaining structure" and "securing structure" as claimed are nowhere described or suggested in the Graw, Henn, or Pazzano references. As with Claim 1, these references expressly teach away from Claim 11 by describing structure that engages the *outside of a container*. This distinction overcomes the rejection under 35 U.S.C. § 102(b). Additional differences distinguish the teachings of Graw, Henn, and Pazzano from the claims in the present application. For example, Graw does not teach a friction retention system of any sort, but rather teaches a cage retention system that allows a user to easily insert and withdraw a beverage container from the coiled cage.

Applicants respectfully submit that Claims 1 and 11 and those claims dependant thereon are patentable over the Graw, Henn, and Pazzano references, or any combination thereof. The rejection of the claims under 35 U.S.C. § 102(b) should be withdrawn.

Allowable Subject Matter

Applicants thank the Examiner for noting the allowable subject matter in Claims 9, 10, 14, 15, 18, and 20. In view of the allowability of Claims 1 and 11 as discussed above, applicants submit these claims are allowable in their present form.

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100

CONCLUSION

The claims in the present application are all patentably distinguished over the teachings of Graw et al., Henn, and Pazzano, taken alone or in combination. Applicants further submit that all objections to the drawings and claims have been overcome. Accordingly, applicants request reconsideration and allowance of the claims, and passing of the application to issue at an early date. Should the Examiner have any remaining questions concerning this application, the Examiner is invited to contact the applicant's undersigned attorney at the telephone number indicated below.

Respectfully submitted,

CHRISTENSEN O'CONNOR
JOHNSON KINDNESS^{PLLC}



Kevan L. Morgan
Registration No. 42,015
Direct Dial No. 206.695.1712

I hereby certify that this correspondence is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to **Mail Stop Amendment**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, on the below date.

Date: July 22, 2004 Raymond Zell

KLM:fjs

LAW OFFICES OF
CHRISTENSEN O'CONNOR JOHNSON KINDNESS^{PLLC}
1420 Fifth Avenue
Suite 2800
Seattle, Washington 98101
206.682.8100